

MPEP 2142 states that in order for a *prima facie* case of obviousness to be established three basic criteria must be met, one of which is that the reference or combinations of references must teach or suggest all the claim limitations. Applicant submits that the combination of Buchanan et al. and Griggs lacks the teaching of at least several of the claim limitations in independent claims 6, 13 and 22.

Specifically, for example, the combination of Buchanan et al. and Griggs does not disclose or suggest at least the following: (1) respecting claim 6, "data storage that stores data representative of *an image of at least one document relating to the transcription proceeding*" and "a screen *that displays the transcript text as it is produced and the image of the at least one document for viewing*", (2) respecting claim 13, "data storage that stores data representative of *an image of at least one document relating to the transcription proceeding*" and a "processor, as the transcriber produces the transcript text, *directing display on the screen of the transcript text and the image of the at least one document for viewing*", and (3) respecting claim 22, "displaying *the transcript text on the screen for real time viewing*", and "displaying *on the screen an image of the first document.*"

In contrast, Buchanan et al. discloses a document generation system that uses "boiler plate" for enhancing or replacing the dictation and transcription process (such as disclosed in Griggs) for the creation of a document. Buchanan et al. does not disclose or suggest storage of at least one document *related to* the document being generated or the display of that at least one document, as claimed by Applicant. Buchanan et al. therefore also only deals with a single document that is being created.

Moreover, Griggs does not make up for this deficiency in Buchanan et al. There is no discussion or suggestion in Griggs whatsoever of storage of at least one document *related to* the transcription or the display of that at least one document, as claimed by Applicant. Griggs therefore also deals with only a single document that is being created.

Thus, the combination of Buchanan et al. and Griggs only deals with a single document that is being created, and does not disclose or suggest the storage and display of a document that is related to the document being created.

In contrast, as more completely discussed above, Applicants' claims are generally directed to at least two different documents, namely, the transcript text (i.e., the document

being created) *and* at least one document related to the transcription proceeding (and thus related to the transcript text). Applicant's independent claims 6, 13, and 22 recite data storage that stores data representative of *an image of* at least one document and display of *the image of* the at least one document.

As an illustrative example, Applicant's claimed invention enables an attorney or judge, for example, to view an image of a document that has been entered into evidence as an exhibit, for example, as well as testimony (i.e., transcript text) from a witness who is testifying about the exhibit while the testimony is being taken, both on a single screen, for example. The combination of Buchanan et al. and Griggs does not disclose or even suggest this capability.


With regard to the rejections of claims 7-12, 14-21 and 23-27, those claims depend from claims 6, 13 and 22, respectively, and also include the limitations discussed above. Therefore, based on the above amendments and arguments, Applicant believes that the rejection of all claims 6-27 under 35 U.S.C. §103 in view of the combination of Buchanan et al. and Griggs has been overcome.

In view of the fact that more than a year and a half has passed since Applicant paid the issue fee in this case, Applicant respectfully requests that the present case be allowed and passed back to publications in an expedited manner. Should the Examiner disagree that the claims are allowable or believe that any issues remain unresolved, Applicant respectfully requests a phone interview with the Examiner and the Examiner's supervisor.

A Supplemental Notice of Allowability is courteously solicited. Please direct all telephone inquiries to the undersigned at (312) 775-8108.

Respectfully submitted,

Dated: September 6, 2002

By: 

Christopher C. Winslade
Reg. No. 36,308

Correspondence address:

James Buch
Engage Incorporated
1302 E. Forest Avenue
Wheaton, Illinois 60187